

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alex Roche	§	Art Unit:	3625
		§		
Serial No.:	10/088,715	§		
		§	Examiner:	William J. Allen
Filed:	March 19, 2002	§		
		§		
For:	Method and Apparatus for	§	Atty. Dkt. No.:	60004065-4
	Automated On-Line Printing	§		(HPC.0541US)
	Service	§		

Mail Stop Appeal Brief-Patents

Commissioner for Patents

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REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer October 17, 2008.

I. REPLY TO EXAMINER'S ANSWER REGARDING THE REJECTION OF CLAIMS 1, 63, 64, 67, 68, AND 73

Previously, Appellant argued that the teachings of Garfinkle are inconsistent with the teachings of MediaFlex, and that therefore, the obviousness rejection is defective. The Examiner argued that MediaFlex discloses a mechanism to offer a direct service to business customers for generating and ordering print products out of their own content. However, this teaching of MediaFlex is inapplicable to the system of Garfinkle, which requires that a developer, scanning center, and image servers be made available to photographers so that photographic images taken by such photographers are made available to the photographer. Garfinkle provides absolutely no hint that it would be beneficial to allow the photographers direct access to an on-line print center, as disclosed in item 1 on page 3 of MediaFlex. In fact, providing direct access to an on-line print

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center by a photographer, as suggested by MediaFlex, would significantly change the principle of operation of the Garfinkle system, since Garfinkle requires that a developer, scanning center, and image servers be provided to allow for development of photographic images from photographic film and scanning of such film at a scanning center for storage on image servers.

Effectively, what the Examiner is suggesting is that the developer and scanning center components of Garfinkle be eliminated, with the MediaFlex Corporate Image Center (MCIC) system incorporated into Garfinkle to allow clients access to their digital pictures maintained on a web-based server controlled by the printing vendor, as taught by MediaFlex. Such a proposed modification of Garfinkle and MediaFlex is based on classic impermissible hindsight, where the teachings of the invention are used as a template to piece together elements of prior art references in an attempt to achieve the claimed invention, even though doing so would significantly change the principle of operation of the Garfinkle. As cautioned by the Supreme Court in *Graham v. John Deere*, impermissible hindsight reconstruction cannot be used to combine reference teachings. *Graham v. John Deere*, 383 U.S. at 36 (“They may also serve to ‘guard against slipping into use of hindsight,’ ...and to resist the temptation to read into the prior art the teachings of the invention in issue.”) (citations omitted).

The Examiner argued that the claim elements “are all known, the technical ability exists to combine the known features to yield predictable results, and the elements perform the same function when combined.” 10/17/2008 Examiner’s Answer at 6. Appellant respectfully submits that since incorporating MediaFlex into Garfinkle would result in a significant change in the system of Garfinkle, the purported combination would not have resulted in “elements perform[ing] the same function when combined.” In fact, based on the proposed modification of Garfinkle, the developer and scanning center of Garfinkle would be eliminated; thus, not only

would the developer and scanning center **not** be performing the same function when combined, the developer and scanning center would be removed from operation, since Mediaflex teaches that clients provide their own content. Therefore, the obviousness rejection is defective for at least the reason that no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of the references to achieve the claimed invention.

Reversal of the final rejection of the above claims is respectfully requested.

II. **REPLY TO EXAMINER'S ANSWER REGARDING THE OBVIOUSNESS REJECTION OF CLAIM 72**

In the Examiner's Answer, the Examiner conceded that the cited references fail to disclose "itemizing separately, for each of a **plurality of print service providers**, a delivery print for delivery from the print service provider to a delivery address, and a print price, for printing at least one print product, defined in the second order type," as recited in claim 72. Examiner's Answer at 7. Despite this concession, the Examiner stated that "[t]hough von Rosen only discloses a single print service provider, performing such tasks for a plurality of providers versus a single provider falls within the ordinary capabilities of one [of] ordinary skill in the art." *Id.*

This constitutes a conclusory statement regarding obviousness of claim features that clearly do not appear in the cited references. The Examiner cited Figs. 10A-11B of von Rosen as purportedly disclosing this feature of claim 72. These figures of von Rosen depict a checkout web page 200 (Figs. 10A-10B) and a confirmation web page 202 (Figs. 11A-11B). The checkout web page 200 receives a consumer's billing address and shipping address, and for receiving payment information from the consumer. von Rosen, 10:47-54. The confirmation web page 202 displays a summary of the consumer's order, including the short description of the

order, order date, order time, billing address, shipping address, order quantity and type, and credit card information. *Id.*, 10:59-63. However, there is absolutely no teaching or hint here of itemizing separately, for each of a plurality of print service providers, a delivery price for delivery from the print service provider to a delivery address. Claim 72 specifically calls for a plurality of print service providers and an itemization of delivery prices for such print service providers. No teaching or hint of this claim feature is provided by any of the cited references.

Because no factual evidence exists that would have hinted at a modification of the cited references to achieve the claimed invention, the obviousness rejection of this claim is clearly defective.

Therefore, reversal of the final rejection is respectfully requested.

III. CONCLUSION

In view of the foregoing, and in view of the arguments presented in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

Date: _____

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